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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,308	03/29/2001	Usman A.K. Sorathia	82,222	7684

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Naval Surface Warfare Center
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EXAMINER

FEELY, MICHAEL J

ART UNIT PAPER NUMBER

1712

7

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-7

Office Action Summary

Application No.

09/822,308

Applicant(s)

SORATHIA, USMAN A.K.

Examiner

Michael J Feely

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: copy of 128 USPQ 440.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of claims 1-16 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of claims 1-5, 9-10, and 12-16 under 35 U.S.C. 103(a) as being unpatentable over Licht (US Pat. No. 4,467,577) stands for the reasons set forth in paragraph 11 of paper #5.
5. The rejection of claims 1-5, 7, 9-10, and 12 under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al. (US Pat. No. 5,578,369) stands for the reasons set forth in paragraph 12 of paper #5.
6. The rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al. (US Pat. No. 5,678,369) in view of Licht (US Pat. No. 4,467,577) stands for the reasons set forth in paragraph 9 of the paper #3.

Response to Arguments

7. Applicant's arguments filed July 11, 2002 have been fully considered but they are not persuasive. Applicant argues that *1)* the case of Ex parte Rubin, 128 USPQ 440, relates to double patenting issues only rather than the standard for rendering an obviousness judgment

Art Unit: 1712

under 35 U.S.C. 103; therefore, the case does not sanction the rejection of record under 35 U.S.C. 103; 2) the claim limitation of in-situ infusion of the fire resisting agent into the barrier layer before its attachment achieves an unexpectedly beneficial result in reducing installation costs (as referred to on page 1, lines 10-14 of the Specification); and 3) the Examiner has relied on hindsight speculation.

Regarding argument 1), the Examiner disagrees with the Applicant that *Ex parte Rubin* relates only to double patenting rejections. MPEP § 2144.04 discloses:

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

; and MPEP § 2144.04 (IV-C), recites:

C. Changes in Sequence of Adding Ingredients

Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclose a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process for making a laminated sheet by reversing the order of the prior art process steps.).

Furthermore, MPEP § 804 (II-B-1), reads:

A double patenting rejection of the obvious-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). **Therefore, any analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination.** *In re Braat*, 937 F.2d 589, 19 USPQ3d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Because the analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination, the decision set forth in *Ex parte Rubin*, 128 USPQ 440, would also apply to analysis of a 35 U.S.C. 103 obviousness determination in the instant application. Therefore, the rejection stands.

Regarding argument 2), the non-persuasiveness of argument 1) renders argument 2) moot.

Regarding argument 3), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely
August 15, 2002



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700